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Mailed : 2-22-08
In re Application of
Curt Thies
Serial No. 10/769,210
Filed: January 30, 2004
For: BEADING

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: DECISION ON
: PETITION
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This is a decision on the PETITION UNDER 37 CFR 1.144 TO WITHDRAW THE RESTRICTION REQUIREMENT mailed August 29, 2006 and made final in the office action mailed May 2, 2007.

Applicants filed an appeal brief on June 21, 2006, appealing the final rejection of claims 1-14. In an office action mailed August 29, 2006, the examiner re-opened prosecution and required restriction between six groups of inventions. Restriction had not been required previously. Applicants traversed the restriction requirement in a response February 15, 2007. The examiner repeated the restriction requirement in an office action mailed May 2, 2007 and made the restriction requirement final. Claims 3-8 and 11-14 were withdrawn from consideration as being drawn to a non-elected invention.

On July 25, 2007, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Petitioner argues that the restriction as maintained is improper because continued examination of all the claims could be made without serious burden.

DECISION

Section 803 of the MPEP states:

803 Restriction — When Proper

Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 802.01, § 806.06, and § 808.01) or distinct (MPEP § 806.05 - § 806.05(j)).

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they

include claims to independent or distinct inventions.

In making the restriction final, the examiner states that the claims as amended require a burdensome search and concludes that restriction between the inventions is proper.

Petitioner argues that there is no serious burden on the examiner to search all of the claims in the application. This argument is persuasive. The examiner has not established that any serious burden exists to examine all of the claims. The lack of a burden is evidenced by the fact that the examiner has previously examined all of the claims. Therefore, the restriction requirement is improper and should be withdrawn.

Accordingly, the restriction requirement is found to be improper and the petition to withdraw the restriction requirement is **GRANTED**. The application is being forwarded to the examiner in order to rejoin non-elected claims and issue a new and complete non-final office action.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022